

**REMARKS**

**I. Status of Claims**

Claims 1 through 77 have been canceled without prejudice or disclaimer. New claims 78 through 167 are presented herein to place the claims in better conformity with U.S. patent practice. Support for these new claims can be found in the specification as filed and the original claims. Therefore, no issue of new matter has been introduced.

**II. Response to Restriction/Election Requirement**

In the Office Action mailed May 1, 2008, the Examiner required restriction among the following groups of claims:

I. Claims 1-69 (i.e., currently new claims 78-159), drawn to a nail varnish composition;

II. Claims 70-76 (i.e., currently new claims 160-166), drawn to a cosmetic assembly; and

III. Claim 77 (i.e., currently new claim 167), drawn to a cosmetic process.

See Office Action, page 2.

Applicants respectfully traverse the restriction requirement for at least the reason as set forth below. However, to be fully responsive, Applicants elect the subject matter of Group I, i.e., currently new claims 78-159, drawn to a nail varnish composition.

In the Office Action, the Examiner asserts that Groups I-III are directed to inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1. Office Action, page 2. Applicants respectfully disagree, because Groups I-III share common special technical features. See 37 C.F.R. § 1.475, which

governs national stage applications and states:

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(Emphasis added).

Further, M.P.E.P. § 1850 III.A clearly instructs that inclusion of different categories of claims in the same international application is *permissible*. For instance, Groups I and III, directed to a cosmetic composition and a cosmetic makeup or care process, can be included in the same application. See M.P.E.P. § 1850 III.A. Thus, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

The Examiner also requires election of species if Group I is selected. Office Action, page 3. Specifically, the Examiner asserts that the species are not so linked as to form a single general inventive concept under PCT Rule 13.1. *Id.* Therefore, the Examiner requires Applicants to elect single species of:

- 1) the monomers recited in claims 13, 14, 16, 17, 20, 24, 29, 30, 35, 39, 40, 44, and 45 with defined R', R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub>, R<sub>4</sub>, R<sub>5</sub>, R<sub>6</sub>, R<sub>7</sub>, and R<sub>8</sub> groups, where appropriate;
- 2) the additional monomer recited in claims 48-52; and
- 3) the organic solvent medium recited in claim 62.

*Id.*

Applicants respectfully traverse the election requirement for at least the reasons as set forth below. However, to be fully responsive, Applicants elect:

-methyl methacrylate (i.e., methacrylates of formula  $\text{CH}_2=\text{C}(\text{CH}_3)\text{-COOR}_1$  with  $\text{R}_1=\text{methyl}$ ) recited in currently new claims 90 and 91; and methyl acrylate, (i.e., acrylates of formula  $\text{CH}_2=\text{CHCOOR}_3$ , with  $\text{R}_3=\text{methyl}$ ) recited in currently new claims 93 and 94,

-the acrylic acid recited in currently new claim 132 as the additional monomer, and

-the butyl acetate recited in currently new claim 148 as the solvent medium.

Under 37 C.F.R. §§ 1.141 and 1.146, the Office is authorized to restrict two or more inventions that are independent and distinct when contained in one application but an application can have more than one species, not to exceed a reasonable number. See, e.g., 37 C.F.R. § 1.141(a). In this case, the application includes sufficiently few species not exceeding a "reasonable" number and hence should be included in a single search and examination. Therefore, Applicants respectfully request the election requirement be withdrawn.

If the Examiner chooses, however, to maintain the election requirement, Applicants respectfully submit that the Examiner should, if the elected species is found allowable, continue to examine the full scope of the pending claims to the extent necessary to determine the patentability of these pending claims, i.e., extending the search to a reasonable number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121. Moreover, if the restriction requirement is maintained among the claims of Groups I-III, Applicants respectfully remind the

Examiner of the obligation to rejoin the non-elected claims under M.P.E.P. § 821.04, should the elected claims be found allowable.

The Examiner indicates that claims 1-12, 15, 18, 19, 21-23, 25-28, 31-34, 36-38, 41-43, 46, 47, 53-61, and 63-69 in Group I are generic claims. Office Action, page 4. Therefore, in view of above, new claims 78-159 are subject to examination.

### **III. The Morrissey Reference**

The Examiner also alleges that U.S. Patent No. 6,106,820 to Morrissey et al. ("Morrissey") anticipates a number of claims of the instant application. See Office Action, pages 2-3. Applicants respectfully disagree with the Examiner. However, as the Examiner has not raised a formal rejection against any of the pending claims in view of Morrissey in the Office Action, Applicants respectfully reserve the right to respond if the Examiner applies Morrissey to reject specific claims in an Office Action.

### **IV. Objection**

The Examiner has further objected to claims 4-59 and 73-76 for being in improper dependent form. Office Action, page 4. This object becomes moot in view of the cancellation of those rejected claims in the present Amendment. Therefore, Applicants respectfully request this objection be withdrawn.

### **V. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this Preliminary  
Amendment and Response to Restriction/Election Requirement and charge any  
additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:

A handwritten signature in black ink, appearing to read 'Ali I. Ahmed', is written over a horizontal line.

Ali I. Ahmed  
Reg. No. 56,848

**Dated: June 2, 2008**